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Richard J. Knapp

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EXAMINER

NGUYEN, TAN D

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/047,717	Applicant(s) KNAPP, RICHARD J.	
	Examiner Tan Dean D. Nguyen	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,4,6-9,12-14,16,19,21 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-4, 6-9, 12-14, 16, 19, 21, 25-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed 3/18/09 has been entered. Claims 25, 26 and 27 have been amended.

Claim Status

2. Claims 3-4, 6-9, 12-14, 16, 19, 21, 25-28 are pending. They comprise:

1) system: 25, 3-4, 6-9, and 12-14 and

2) method: 26, 16, 19, 21, and 27-28.

Claims 1-2, 5, 10-11, 15, 17-18, 20 and 22-24 have been canceled.

As of 3/18/09, independent system claim 25 is as followed:

25. (Currently Amended) A system for facilitating the creation, organization and exchange of information communications between specifiers and suppliers, the system comprising:

a) one or more specifier workstations, each specifier workstation including:

i. means for defining ~~predefining~~ a plurality of specifier shades, a plurality of specifier substrates, and a plurality of suppliers, wherein each specifier shade is characterized by a set of spectral data;

ii. means for storing the defined ~~predefined~~ pluralities of specifier shades, specifier substrates and suppliers in a specifier database;

iii. means for creating a nested e-palette for a set of goods, said creating means including means for:

1. selecting, from the specifier database, a set of one or more of the plurality of specifier substrates,

2. associating the selected set of one or more specifier substrates with the set of goods,

3. selecting, from the specifier database, a set of one or more of the plurality of specifier shades to correspond with each substrate of the selected set of one or more specifier substrates, and

4. associating, the corresponding selected set of one or more specifier shades with each substrate of the selected set of one or more specifier substrates,

wherein each substrate of the selected set of one or more specifier substrates and each shade of each selected set of one or more specifier shades defines a nesting within the nested e-palette;

iv. means for selecting from the specifier database a predetermined set of one or more of the plurality of suppliers for association with one or more of the nestings within the nested e-palette; and

v. means for uploading the nested e-palette to a server;

b) a server in communication with the one or more specifier workstations, the server including:

i. means for remotely storing one or more nested e-palettes uploaded from the one or more specifier workstations;

ii. means for automatically communicating the existence of each uploaded nested e-palette to the predetermined set of suppliers associated with the nestings within the nested e-palette; and

iii. means for restricting access to at least one of: (1) each uploaded nested e-palette and (2) each of the nestings within each uploaded nested e-palette, based upon the predetermined sets of suppliers associated with the nestings within the uploaded nested e-palletes;

c) one or more supplier workstations in communication with the server, each supplier workstation including:

i. means for remotely accessing one or more of the uploaded nested e-palettes;

ii. means for filtering the one or more uploaded nested e-palettes for at least one of: (1) one or more nested e-palettes and (2) one or more nestings within the uploaded nested e-palettes;

iii. means for importing submission data for one or more supplier shades associated with one or more supplier substrates, the submission data including sets of actual spectral data from one or more test samples;

iv. means for comparing the sets of actual spectral data to the sets of spectral data associated with the uploaded nested e-palettes; and

v. means for uploading the submission data to the server for review by one or more specifiers if deviations between the sets of actual spectral data and the

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sets of spectral data associated with the uploaded nested e-palette are within acceptable limits.

Principles of Law About Claims

3. When a claim uses the term "means" to describe a limitation, a presumption inheres that the inventor used the term to invoke § 112, p 6. *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1375 (Fed.Cir.2003). "This presumption can be rebutted when the claim, in addition to the functional language, recites structure sufficient to perform the claimed function in its entirety." *Id.* Once a court concludes that a claim limitation is a means-plus-function limitation, two steps of claim construction remain: 1) the court must first identify the function of the limitation; and 2) the court must then look to the specification and identify the corresponding structure for that function.

Med. Instrumentation & Diagnostics Corp. v. Elekta AB, 344 F.3d 1205, 1210 (Fed. Cir. 2003).

"If there is no structure in the specification corresponding to the means-plus-function limitation in the claims, the claim will be found invalid as indefinite." *Biomedino, LLC v. Waters Technologies Corp.*, 490 F.3d 946, 950 (Fed. Cir. 2007); *see also In re Donaldson*, 16 F.3d 1189, 1195 (Fed. Cir. 1994) (en banc).

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 4, 6, 12-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to more than one class of statutory subject matter.

The independent claim 25 begin by discussing a system (apparatus), however dependent claims 4, 6, 12-14 37 respectively use language that is used in a method claim, such as “enables”, “is selected”, “is characterized”, “are used”, etc. "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only". See Ex parte Lyell (17 USPQ2d 1548).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 25, 3-4, 6-9, and 12-14 (system) and 26, 16, 19, 21 and 27-28 (method) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In independent system claim 25, claim element “means for defining” in (i), “means for storing” in (ii), “means for creating” in (iii),, "means for uploading", in element (c), (v), are a means (or step) plus function limitation that invokes 35 U.S.C.

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112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function.

The cited portion of the specification on pages 12-14, especially page 14, lines 6-23, describes generally that a series of exemplary screen shots, Figs. 4-17, are provided for communicating and managing transfer(s) of color information and/or associated tolerance specifications to and among a distributed network of users. Also,

with more specific reference to Figs. 4-10, a series of exemplary screen views for use by a designer/specifier in establishing an e-palette are provided. Each of these screens is generally accessed and information/data input to and retrieved from such screens using conventional browser technology. With particular reference to Fig. 4, exemplary screen 250 includes a plurality of links that may be used by a designer/specifier in connection with advantageous functionalities associated with the present disclosure. Of note, three primary links are provided in the upper left region of screen 250, namely a "Quality" link 252, "Define" link 254, and "Admin" link 256. Therefore, it appears that the specification does not provide any specific algorithm that could be implemented on a general purpose computer to carry out all the functions in the "means plus function" limitations above. The written description fails to disclose the corresponding structure, material, or acts for the claimed function.

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

8. In independent **system claim 25**, claim element claim element “means for defining” in (i), “means for storing” in (ii), “means for creating” in (iii), ..., “means for uploading”, in element (c), (v), are a means means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function. See the above citation.

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Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it clearly links or associates the corresponding structure, material, or acts to the claimed function without introducing any new matter (35 U.S.C. 132(a)); or

(c) State on the record where the corresponding structure, material, or acts are set forth in the written description of the specification that perform the claimed function.

For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 26, 16, 19, 21, and 27-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As indicated above, claim 26, the steps of (b) and (c), and the steps of items i, ii, iii, iv, and steps (d)-(j), which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim Rejections - 35 USC § 112

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10. Claims 4, 6, 12-14, 19 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) Claims 4, 6, 12-14 are vague and indefinite since the dependent claims uses "method steps" such as "enables", "is selected", "is characterized", "are used", etc., in an apparatus claims. See *IPXL Holdings. Va. Amazon.com* (Fed. Circuit 2005). System claim that includes a method step is invalid as indefinite.

2) In dep. claim 19, the use of the alphabetical letters of "a." and "b." are vague because these letters have been used in independent claim 26 already.

3) Claim 28 recites the limitation "said color measuring equipment using a profiling system" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 25, 3-4, 6-9, and 12-14 (system), and 26, 16, 19, 21, 27-28 (method) and are rejected under 35 U.S.C. 103(a) as obvious over BADE ET AL in view of (2) PLANALP et al, (3) YON et al and (4) KURZIUS et al.

As for independent claims 25 (system) and 26 (method), BADE et al discloses a system/method for facilitating communications (or "...**collaborative** *method of designing systems ...*" {see par. 0022"}) between plurality of entities for ordering of goods (procurement of goods), 1st entity functions as a specifier and a 2nd plurality of entities function as plurality of suppliers, said system/method comprising:

Means and step for receiving information from an order across a computer network at a server, the information originating from a 1st entity (specifier) workstation and including information about the desired product in the project/design project, said information associated with the product defined by the 1st entity (specifier), the information associated with the project/design including a set of goods (product) and a predetermined set of suppliers;

{see Figs. 2, 41, paragraphs [0009], [0023], [0108], [0111], and [0207]}

b) automatically communicating to said predetermined set of suppliers the existence of said project/project design at said server; and

{see paragraphs [0207]-[0208], Figs. 8 and 44]}

c) permitting remote access to said project/project design by said predetermined set of suppliers at said server.

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{see [0023 "...a vendor to access a design published by a designer on the bidding board... vendor may receive a request for quote that includes access privilege to the design..."], [0207]}}.

BADE et al fairly teaches the claimed invention except for the features of the information in the order/quote received contains specified color data spectra or e-palette information and information associated with the specified e-palette and

- "means for defining a plurality of specifier shades (colors), a plurality of specifier substrates (product, raw material types) and a plurality of suppliers" (claim 25);
- "using one of the specifier workstations to predefine a plurality of specifier shades (colors), a plurality of specifier substrates (product, or materials) and a plurality of suppliers" (claim 26);
- "means for creating a nested e-palette for a set of goods" (claim 25); "using the one of the specifier workstations to create a nested e-palette for a set of goods" (claim 26); and
- "means for filtering the one or more uploaded nested e-palettes" (claim 25).

In a similar system/method for facilitating the creation, organization and exchange of information between various business parties involved in the product development design project on the Internet, **PLANALP et al** discloses:

- "means for defining a plurality of specifier shades (color),

{see Fig. 16, "Molded Parts **Color**_Ref: 61FT97"}
 a plurality of specifier substrates,

{see Fig. 16, material type: "POLYESTER"}},

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and a plurality of suppliers" (claim 25); "using one of the specifier workstations to predefine a plurality of specifier shades (color) "Molded Parts **Color_Ref:** 61FT97", a plurality of specifier substrates (material type: "**POLYESTER**"), and a plurality of suppliers" (claim 26);

{see Fig. 16, Fig. 2, list 162, col. 7, lines 12-20, Fig. 22, 30, col. 17, lines 14-32}}.

PLANALP et al discloses several advantages/benefits of the system such as shown on col. 2, lines 52-57", col. 3, lines 50-67, "capable of use across various businesses and geographic regions throughout a diverse enterprise to improve economies of scale in product and package design and material procurement. Electronic communication ... to meet global regulatory requirements and improves efficiency of the product development process". See also col. 17, lines 15-30,

Figure 30 illustrates a representative supplier approval matrix according to one embodiment of the present invention. The supplier approval matrix may include supplier information 990 in addition to approved use information 992. Having material supplier information linked to material name, usage, and clearance information allows a user to search for materials approved from a given supplier, or suppliers approved for a given material, or any of a number of powerful searches depending upon the particular application. Representative supplier information may include the manufacturer and location, a manufacturer classification, status, trade name, and related code, for example. Approved use information 992 may be linked to supplier information by manufacturer and location, for example. In addition, approved use information 992 may include business unit, product category, brand name, product name, and related information. Preferably, each specification or standard is linked to the supplier approval information for ease of user navigation, searching, and reporting.

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art (PHOSITA) to modify the teachings of BADE et al to include the specific defining of designed product specification as taught by PLANALP

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et al for improving efficiency of the product development process and product procurement process while meeting global regulatory requirements by using approved materials and suppliers with clearance information and products.

Similarly, **YON et al** discloses a method for facilitating communications between 2 entities, first entity serving as a specifier and a 2nd entity serving as one or more suppliers, said method comprising:

a) receiving an order in the form of electronic (web) template/page or palette across a computer network at a server, said template/page (palette) originating from a specifier (customer or purchaser) workstation and including parameters related to said template/palette, said parameters including a set of goods (product) and a predetermined set of suppliers associated with said template/palette by said specifier (customer/purchaser);

{see Figs. 1, 2, elements 32, 34, 36, 44, Fig. 4, elements 52, Fig. 6, 60, cols. 3, lines 5-65, col. 4, lines 5-40, col. 7, lines 1-65}

b) automatically communicating to said predetermined set of suppliers the existence of said template/web page (palette) at said server; and

{see Fig. 1, col. 3, lines 4-45, col. 7, lines 1-60}}

c) permitting remote access to said template/palette by said predetermined set of suppliers at said server.

{see col. 3, lines 4-40, col. 7, lines 1-12, col. 8, lines 4-45}.

Note, as for the term “e-palette” which appears to be similar to electronic template or page or web page, this is taught in YON et al on cols. 3-4, Figs. 2-5. Note

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that on col. 4, lines 15-20, YON et al discloses the field (44) on Fig. 2 as “color palette field”. Therefore, the teaching of Fig. 2 reads over “e-palette”. Alternative, since the palettes of Fig. 2 and col. 4, lines 1-25 are transferred via electronically (via the Internet), it would have been obvious to change the name of web page or template in YON et al to e-palette if desired to indicate that the palette is carried out electronically.

It would have been obvious to modify the procurement of design product of **BADE et al / PLANALP et al** to include specified color data spectra or e-palette information and information associated with the specified e-palette as taught by **YON et al** if the design item requires color feature or desired color as taught by YON et al {see cols. 1-2, Figs. 2-6.

The teachings of BADE et al /PLANALP et al /YON et al appears to fail to teach the last limitation of

- "means for filtering the one or more uploaded submission or “nested e-palettes” (request for proposal) submitted by the specifier or requester (claim 25).

In a system/method for the management of requester’s information (submission or request for proposal), **KURZIUS et al** fairly teaches the practice of using a “means/step for filtering” (filtering engine or “screening the profiles”) to perform a gatekeeping or filtering function using automated benchmarks by which the submitted data or requester’s profile is evaluated to improve evaluation or screening efficiency since only qualified information is being reviewed and/or treated {see col. 4, lines 30-45, col. 7, lines 47-67, col. 8, lines 1-26, Figs. 1-3, element 36 “FILTER ENGINE”.

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It would have been obvious to modify the procurement of design product of BADE et al / PLANALP et al /YON et al to include means/step for filtering" (filtering engine or "screening the profiles") as taught by KURZIUS et al to perform a gatekeeping or filtering function using automated benchmarks by which the submitted data or requester's profile is evaluated to improve evaluation or screening efficiency since only qualified information is being reviewed and/or treated.

As for dep. claims 3-4 (part of 25 above), which deal with well known features of the server and communication network, i.e. LAN or WAN or Internet, these are taught in BADE et al, Fig. 42, 41, 43 or PLANALP et al Fig. 3, or YON et al Fig. 1 "Internet". color spectra data or e-palettes parameters and order parameters, these

As for dep. claim 6 (part of 25 above), which deal with well known color spectra data or e-palettes parameters and order parameters, these are well known and are taught in cols. 3-5 or 7 or Figs. 2, 4 and 6 of YON et al. Note also, that these are further limitation or functions on the information/data received in step (c) and stored in the database, they are considered as non-functional descriptive material (NFDM) and have no patentable weight. Data are data and functions or intended use on the data have no patentable weight unless the function or intended use of the data are carried out.

As for dep. claim 7 (part of 25 above), which deal with well known product procurement process or request for proposal, i.e. supplier submission condition or product price, these are taught in BADE et al, pars. [0009], [0207], [0214], or PLANALP et al Figs. 30, Fig. 9, and Figs. 2 and 5.

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As for dep. claim 8 (part of 25 above), which deal with well known color spectra data or e-palettes parameters and order parameters, these are well known and are taught in cols. 3-5 or 7 or Figs. 2, 4 and 6 of YON et al.

As for dep. claim 9 (part of 25 above), which deal with well known practice for checking or validating operation of a color measuring (matching) equipment related in the transaction to ensure proper color communication between two entities, this is taught in col. 4, lines 26-65, col. 7, lines 15-67, Fig. 6.

As for dep. claims 12-13 (part of 25 above), which deal with well known reporting means for review, these are taught in BADE et al Fig. 6, "Reporting", PLANALP et al Figs. 10.

As for dep. claim 14 (part of 25 above), which deal with network communication language protocol type, i.e. CxF language, this is inherently included in the network system of BADE et al/PLANALP et al /YON et al and KURZIUS et al.

Furthermore, as indicated above, the phrase "...to access...", "...to facilitate..." in dep. claims 12-14 are not a positively recited method step but, rather, is mere intended use of the reporting means or protocol, thus having no patentable weight. See MPEP 2173.05 (q), 2106, and 2111.04, which indicate that a method claim requires active, positive steps.

As for dep. claims 16, 19 (part of 26 above), which have similar limitations as in dep. claims 6 and 13 (part of claim 25 above), they are rejected for the same reasons set forth in the rejections of claims 6 and 13 above.

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As for dep. claim 21 (part of 26 above), which deal with well known color spectra data or e-palettes parameters and order parameters, these are well known and are taught in cols. 3-5 or 7 or Figs. 2, 4 and 6 of YON et al. Note also, that these are further limitation or functions on the information/data received in step (c) and stored in the database, they are considered as non-functional descriptive material (NFDM) and have no patentable weight. Data are data and functions or intended use on the data have no patentable weight unless the function or intended use of the data are carried out.

As for dep. claim 27 (part of 26 above), as indicated above, the phrase "...to predefine a plurality ofspecifier database" is not a positively recited method step but, rather, is mere intended use of the used workstation and thus having no patentable weight. See MPEP 2173.05 (q), 2106, and 2111.04, which indicate that a method claim requires active, positive steps. Furthermore, these limitation appear to be dealt with well known data management, i.e. accessible by a party such as the specifier, this is taught in BADE et al [0023] or [0207]. Moreover, the information/data on database "accessing" feature or parameter by any party such as specifier or supplier, is also taught by YON et al on col. 6, line 65 to col. 7, line 10.

As for dep. claim 28 (part of 26 above), which deal with well known practice for checking or validating operation of a color measuring (matching) equipment related in the transaction to ensure proper color communication between two entities, this is taught in col. 4, lines 26-65, col. 7, lines 15-67, Fig. 6.

Note on col. 8, lines 33-40, "understood by those skilled in the art that various changes may be made and equivalents maybe substituted for elements thereof without

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departing from the scope of the invention.... Many modifications....", these limitations as shown in the above dependent claims are well known non-essential inputs, changes and/or modifications to provide effective e-communication parameters of various parties involved in an e-transaction related to color features and would have been obvious to a skilled artisan to carry out these parameters.

Response to Arguments

14. Applicant's arguments with respect to claims 25, 3-4, 6-9, and 12-14 (system), and 26, 16, 19, 21, 27-28 (method) have been considered but are moot in view of the new ground(s) of rejection.

15. Applicant's major comments on page 16 of the response of 3/18/09, that BADE et al /YON et al fails to teach 3 features:

- (1) "means for predefining a plurality of specifier shades, a plurality of specifier substrates and a plurality of suppliers" (claim 25); "using one of the specifier workstations to predefine a plurality of specifier shades, a plurality of specifier substrates and a plurality of suppliers" (claim 26);

- (2) "means for creating a nested e-palette for a set of goods" (claim 25); "using the one of the specifier workstations to create a nested e-palette for a set of goods" (claim 26); and

- (3) "means for filtering the one or more uploaded nested e-palettes" (claim 25).

The examiner has cited PLANALP et al, to teach elements (1)-(2) above and KURZIUS et al to teach element (3) above.

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16. In response to applicant's argument that the examiner's conclusion of obviousness of YON et al /BADE et al is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

No claims are allowed.

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17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

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18. In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

19. Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday. Should I be unavailable during my normal working hours, my supervisor Janice Mooneyham can be reached at (571) 272-6805. The main FAX phone numbers for formal communications concerning this application are **(571) 273-8300**. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/

Primary Examiner, Art Unit 3689